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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,448	11/16/2000	Joseph Schapira	16721-0024	6459

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EXAMINER
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THEXTON, MATTHEW

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/06/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/622,448

Applicant(s)

SCHAPIRA ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,4.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant has elected without argument or traverse in paper no. 10, received 30 April 2003.

The review of the art by the Examiner has resulted in the withdrawal of the election requirement for component A, because it is clear that volatile corrosion inhibitors are notoriously well known and applicant's disclosure merely recites well known volatile corrosion inhibitors in the claimed formulations. Since election was made without traverse the restriction is otherwise deemed proper.

Claims 1-8 are generic with respect to at least one of each of the B and C components. No claims are withdrawn since none are limited to non-elected species.

### ***Information Disclosure Statement***

The reference BE-702592 cited by applicant has been lined through on the form PTO-1449 because no copy was made available. However, applicant has indicated in the statement of relevance forming a part of the IDS that US 3425954 is 'part of the patent family' and this reference has been considered.

### ***Claim Rejections - 35 USC § 112 and 35 USC § 101***

Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 10 provides for the use of formulations and articles, respectively, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

These claims are so indefinite that they cannot be treated further on the merits.

***Claim Rejections - 35 USC § 112***

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The phrase "chosen from the group comprising" and similar phrases are unacceptable because comprising is open-ended and thus should be rephrased in accordance with US practice along the lines of "selected from the group consisting of".

The phrase "insoluble filler" in claim 1 is unclear since solubility is relative and no basis for a relation is set forth; insoluble in what?

Claim 1 concludes with the phrase "by means of which the release of volatile corrosion inhibitors is limited to a maximum when the composition or premix is formed." This is unclear since the amount of the "maximum" is not set forth.

In order to assist in the prosecution of this application, the Examiner presents the following as representing the best understanding of the elected claimed invention which forms the premise for examination by the Examiner in this Office Action. Applicant is under no obligation to adopt this format or language.

1. A corrosion inhibiting article comprising a formulation comprising:
  - (a) a polymer which comprises at least 50 weight percent of the formulation and which is selected from the group consisting of:  
polyolefins, such as polyethylene, polypropylene, polybutene, and copolymers thereof with vinyl acetate, acrylic acid, and esters thereof formed from short chain alcohol, polyvinyl chloride, polyamides, polystyrenes, polycarbonates, polyesters, polyurethanes, natural rubber, styrene-butadiene, and polychloroprene;  
and a premix comprising
  - (b) at least one volatile corrosion inhibitor comprising at least one inorganic salt of nitrous acid; and
  - (c) at least one structuring agent comprising at least one mineral wax, such as paraffin, microcrystalline hydrocarbon wax, petrolatum, and

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polyethylene, said wax having a low melting point between 40 and 110 C and which is effective to reduce the release of said volatile corrosion inhibitor when said formulation or said premix is formulated.

### ***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter:

There is no suggestion in the prior art to employ the elected invention of mineral waxes in a premix with volatile corrosion inhibitors and further formulated with at least an equal weight of polymer which may be formed into an article such as sheet, tube, or wire. Therefore, the combination of volatile corrosion inhibitor, mineral wax, and polymer, in the order set forth and proportional limitation set forth is allowable over the art of record upon the satisfactory resolution of the other issues presented in this Office Action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/031472. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 'stopper' of 10/031472 appears to be merely another form of 'packaging article' of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103 or 35 USC § 102***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bortolussi et al. (BR 90-01035), as understood from the USPTO translation.

Bortolussi et al. discloses two part formulations for volatile corrosion inhibitors in which the 'primary' part comprises the volatile corrosion inhibitor and processing aid which reduces friction and shearing level so that lower temperature may be employed

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(page 10, first full paragraph, translation), and the secondary part is a polymer of 80-95 weight percent of the final formulation and which final formulation may be formed into articles such as sheets for packaging metal articles and protecting them from corrosion. The reference discloses that the volatile corrosion inhibitor may be sodium nitrite or other well know agents. The reference discloses that the processing aid may be amines, amides, and glycols (polyethylene glycol) (page 10 of translation).

Although not all combinations of components are exemplified, the four corners of the reference embody the combinations, rendering the polyethylene glycol plus sodium nitrite anticipated by this reference.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the 'primary' formulation of Bortolussi et al. to employ the suggested polyethylene glycol instead of the other processing aids exemplified because it too would provide the reduced friction and shearing levels allowing lower processing temperature and preserving the volatile corrosion inhibitor in the formulation.

#### ***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

As best understood, the elected invention requires a premix formulation of volatile corrosion inhibitor comprising an inorganic salt of nitrous acid and a mineral wax structuring agent (as defined) which is then further formulated with a polymer, forming a composition which is at least 50 weight percent the polymer and capable of being formed into an article such as a film, rod, tube, etc.



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Cited prior art discloses mixtures of volatile corrosion inhibitor with polymers (e.g., Fessler et al. (US 2829080), Boerwinkle et al. (US 4290912), Bortolussi et al. (BR 9001035), Lozano et al. (US 6033599)).

Cited prior art discloses mixtures of volatile corrosion inhibitor with wax (e.g., Wachter et al (US 2643176) and Ruzevick et al. (US 3425954)).

Cooke, et al. (US 2758981) discloses a semi-solid, grease-like formulation comprising wax, an insoluble mineral filler, and sodium nitrite, see claims 1 and 6, and column 3, lines 27-46. This reference anticipates or renders obvious the non-elected embodiment in which the pre-mix constituent is "insoluble filler chosen from the group comprising mineral fillers".

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Friday, 8:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

June 2, 2003



Matthew A. Thexton  
Primary Examiner  
Art Unit 1714